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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,611	12/08/2000	Waheguru Pal Singh	LYNN/0120	4196

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STREETS & STEELE  
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EXAMINER

QAZI, SABIHA NAIM

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 06/18/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/733,611	Applicant(s) SINGH ET AL.	
	Examiner Sabiha Naim Qazi	Art Unit 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-11, 17 and 26-51 is/are pending in the application.
- 4a) Of the above claim(s) 26-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-11 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) 26-51 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***C ntinued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/2/03 has been entered.

Amendments are entered. Claims 1-11, 17 and 26-51 are pending. No claim is allowed at this time. All of the previous rejections are withdrawn. Applicants' arguments regarding claims 26-51 were fully considered, but were not found persuasive because these claims were considered to be broader than claim 1. For example, claims 30 and 41 are drawn to independent claims for a method of preparing the sterilizing solution(s).

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 1-11 and 17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term “comprising” cited in claims is inclusive and fails to exclude unrecited steps. The use of the term comprising to introduce claimed structure means that the ingredients covered by these claims may involve more elements than those positively recited. *Ex parte Gottzein* et al., 168 USPQ 176 (PTO Bd. App. 1969). Comprising leaves the claim open for inclusion of unspecified ingredients even in major amounts. *Ex parte Davis* et al., 80 USPQ 448 (PTO Bd. App. 1948).

Applicant’s claim 6 is drawn to the method of claim 1, wherein the sterilizing solution is “substantially free” of hydrogen peroxide. The term “substantially”, as defined by the Merriam Webster Collegiate Dictionary, means “ample to satisfy and nourish”. This is very unclear because the applicant does not give a specific amount. The word “substantially” is too open-ended; exactly how much hydrogen peroxide is ample enough to satisfy and nourish?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5753770 and US 5674538. See both documents in their entirety and all examples and claims. More specifically, in US '770 see lines 30-36 in Column 6. In US '538 see lines 40-41 in Column 4 and lines 44-45 in Column 5.

Presently claimed invention differs from the reference in claiming specifically a formulation which is substantially free from hydrogen peroxide.

US '770 discloses a process to prepare a hydrogen peroxide and dipercarboxylic acid complex, which can be used as a disinfectant. According to the Merriam-Webster Collegiate Dictionary & Thesaurus, "sterilize" and

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“disinfectant” are synonyms because they both mean “clean”. This leads us to the fact that the prior art already teaches the applicant’s presently claimed invention (a method for producing a dipercarboxylic sterilizing solution).

US ‘538 teaches a method of controlling microbial growth in an aqueous stream by using percarboxylic acid, which embraces applicant’s claimed invention. Furthermore, the reference discloses “the antimicrobial composition of the invention *may* also comprise a hydrogen peroxide constituent.” (Lines 43-44 in Column 5) The word “may”, as defined by the Merriam Webster Collegiate Dictionary, means “can”, so we can replace the word “may” with “can” in the sentence. The sentence now reads: “the antimicrobial composition of the invention *can* also comprise a hydrogen peroxide constituent.” Applicant’s claim 6 is drawn to the sterilizing solution being prepared “substantially” free of hydrogen peroxide.

The prior art teaches that one skilled in the art has the ability to create the sterilizing solution without using hydrogen peroxide at all. The reference goes on to teach that hydrogen peroxide in combination with the percarboxylic acid provides an extra boost in antimicrobial action against microorganisms, but it never states that one *must* use hydrogen peroxide.

It would have been obvious to those with ordinary skill in the art at the time of invention to prepare a dipercarboxylic acid-based sterilizing solution with or “substantially free” of hydrogen peroxide. There is enough motivation in

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the cited references to prepare the solution in the presently claimed invention.

No unobvious or unexpected results are noted.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Naim Qazi whose telephone number is 703-305-3910. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



SABIHA QAZI, PH.D  
PRIMARY EXAMINER

June 16, 2003